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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,551	11/13/2003	Achim Liebold	392-36 CIP	9165
23869	7590	10/24/2006	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICO TURNPIKE SYOSSET, NY 11791			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,551

Applicant(s)

LIEBOLD, ACHIM

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 3 and 28-33 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/11/2006.

Applicant's indication that claims 1, 2 and 4-28 read on the elected embodiment of Figures 1-6 is noted. However, since claim 28 recites "wherein the container is in the form of a suit carrier ..." and since the elected embodiment clearly is not such carrier. Therefor, claim 28 is deemed not to read on the elected embodiment.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 23, the phrase "the side panels" lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4-8 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (4,573,202) or Sadow (5,622,262) in view of Presnick (3,889,743). Lee discloses a

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container (20) comprising a storage compartment having an outer member (22-28), a flexible inner lining (32) and an adjustable protection means (34) for protecting an article in the storage compartment. The adjustable protection means mounted between the outer member and the lining and the adjustable protection means comprises an inflatable insert for selectively adjustable between a protection mode and a storage mode. Sadow discloses in the embodiment of Figures 12-14, a container comprising a storage compartment having an outer member (60), a flexible inner lining (62) and an adjustable protection means (64) for protecting an article in the storage compartment. The adjustable protection means mounted between the outer member and the lining and the adjustable protection means comprises an inflatable insert for selectively adjustable between a protection mode and a storage mode. Lee or Sadow also discloses the other claimed limitations except for the adjustable protection means comprises a self-inflatable insert in lieu of the inflatable insert.

Presnick teaches a container (60) comprising a storage compartment and a self-inflatable insert (40 and column 3, lines 28-30) disposed within the storage compartment for protecting an article. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the adjustable protection means of Lee or Sadow so the adjustable protection means comprises a self-inflatable insert instead of the inflatable insert to reduce the time of inflating the insert.

As to claims 14 and 15, Lee discloses the insert is inflatable by a pump (42) and a release valve (46).

As to claim 16, Lee discloses a tube (60, 70).

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As to claim 21, Lee discloses a handle (142, 150, 152) having a cavity for housing the pump (144) and the tube (168, Figures 6-10) and a shoulder strap (Figure 1). It would have been obvious to one having ordinary skill in the art in view of the embodiment of Figures 6-10 to modify the embodiment of Figure 1 of Lee so the shoulder strap includes a cavity for housing the pump and the tube to reduce the size of the container and to provide more convenient for the user.

6. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Lea et al. (3,872,525; hereinafter Lea'525). The inflatable insert of Lee or Sadow as modified further fails to show the inflatable insert comprises a foam pad insert incorporating an air valve. Lea'525 shows a self-inflatable pad/insert (10) comprising a foam pad (14) and an air valve (16). It would have been obvious to one having ordinary skill in the art in view of Lea'525 to modify the inflatable insert of Lee or Sadow as modified so it comprises a foam pad insert for better protecting the article.

7. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 20 and 23 above, and further in view of The Official Notice. The container of Lee or Sadow further fails to show the attachment means comprises strips of hook and loop material and a flap being provided on the outer member of the container of Lee for covering the zip fastener. The Official Notice is taken of the old and conventional practice of providing a container having attachment means comprises strips of hook and loop material for attaching the side panels together and also the container comprise a luggage having a flap located

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on the outer member of the luggage for covering the zip fastener. It would have been obvious to one having ordinary skill in the art in view of The Official Notice to modify the container of Lee or Sadow so the container comprises attachment means include strips of hook and loop material for attaching the side panels together to facilitate inserting the inflatable insert and the container comprise a luggage having a flap located on the outer member of the luggage for covering the zip fastener for better protecting the article disposed in the compartment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb
October 20, 2006



Luan K. Bui
Primary Examiner
Art Unit 3728